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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/846,377	05/02/2001	Dennis Mendiola	8098.0011	3927

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EXAMINER

EWART, JAMES D

ART UNIT	PAPER NUMBER
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2683

DATE MAILED: 03/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/846,377

Applicant(s)

MENDIOLA ET AL.

Examiner

James D Ewart

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4 and 5</u> . | 6) <input type="checkbox"/> Other: ____ |

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Drawings

1. Figures need to be labeled to indicate what each object represents such as Figure 1; 11, 23,25,27,15,21,19,17,13,29, and 31.

Information Disclosure Statement

2. The information disclosure statement filed 09 October 2001, fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.
3. The information disclosure statement filed 09 October 2001, fails to comply with 37 CFR 1.98(a)(1), which requires a list of all patents, publications, or other information submitted for consideration by the Office. It has been placed in the application file, but the information referred to therein has not been considered.

Claim Objections

4. Claim 17 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

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Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 21 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. This claim is an Omnibus type claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-6, 11, 21, and 22 are rejected under 35 USC 103(a) as being unpatentable over McDowell et al. (U.S. Patent Publication No 2001/0034224) in view of Dennis (PCT/US98/26785).

Referring to claims 1, 11, 21 and 22, McDowell et al. teaches a method for assigning a unique identifier to a prospective user of an instant messaging system comprising a plurality of clients having IM applications of the same or different types (0008), selectively interconnected to an IM server by way of a computer network (Figure 1; 12), the method comprising the following steps: receiving a client specific access address of a prospective user (0029, 0030), automatically

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allocating a unique identifier to the prospective user (0030); matching said unique identifier to the client specific access address of the prospective user (0030) and storing the matched unique identifier and client specific access address with said IM server under the unique identifier (0030), but does not teach registering or tentatively registering an account over a computer network and confirming the registering of the prospective user associated with a direct request to register from the prospective user. Dennis teaches registering or tentatively registering an account over a computer network and confirming the registering of the prospective user associated with a direct request to register from the prospective user (Page 10, Lines 3 - 16 and Figure 1). Therefore it would have been obvious to combine the art of McDowell et al. with the teaching of Dennis teaches registering or tentatively registering an account over a computer network and confirming the registering of the prospective user associated with a direct request to register from the prospective user to provide a system and method for users to control the delivery of information to a wireless device and to control services provided to the device (Page 3, Lines 2-4)

Referring to claim 2, McDowell et al. further teaches wherein the unique identifier is a UIN (0030).

Referring to claim 3, Dennis further teaches wherein said computer network is the internet and/or any direct electronic link (Figure 1; 102).

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Referring to claim 4, Dennis further teaches wherein the prospective user has an email-based client application for accessing the IM system (Page 10, Line 25).

Referring to claim 5, McDowell et al. further teaches wherein the prospective user has a GSM device forming part of a GSM network for accessing the IM system (0014).

Referring to claim 6, McDowell et al. further teaches wherein said GSM network has SMS capability and said prospective user is initially connected to an SMSC server to control and manage said SMS therebetween, and wherein said SMSC server is directly connected to said IM server via said computer network (Figure 1; 18,12,36,38,40).

7. Claims 7, 9, 10, 12-16, 17, and 19 are rejected under 35 USC 103(a) as being unpatentable over McDowell et al. and Dennis and further in view of Patil (U.S. Patent No. 6,625,460).

Referring to claims 7, 9, 17 and 19, McDowell et al. and Dennis teach the limitations of claims 7 and 9 including wherein the prospective user sends client specific address to a web page, but do not teach sending information via e-mail. Patil teaches sending information via e-mail (Column 4, Lines 45-53). Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the art of McDowell et al. and Dennis with the teaching of Patil of sending information via e-mail to enhance the currently available messaging capabilities of SMS (Column 2, Lines 24-25).

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Referring to claim 10, McDowell et al. and Dennis teach the limitations of claim 10 including wherein said client specific address is sourced from a web page, but do not teach sending a message to an IM server from a registered user of said IM system, on any client type accessible to said IM server. Patil teaches sending a message to an IM server from a registered user of said IM system, on any client type accessible to said IM server (Column 4, Lines 45-53). Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the art of McDowell et al. and Dennis with the teaching of Patil of sending a message to an IM server from a registered user of said IM system, on any client type accessible to said IM server to enhance the currently available messaging capabilities of SMS (Column 2, Lines 24-25).

Referring to claim 12, McDowell et al. further teaches wherein the unique identifier is a UIN (0030).

Referring to claim 13, Dennis further teaches wherein said computer network is the internet and/or any direct electronic link (Figure 1; 102).

Referring to claim 14, Dennis further teaches wherein the prospective user has an email-based client application for accessing the IM system (Page 10, Line 25).

Referring to claim 15, McDowell et al. further teaches wherein the prospective user has a GSM device forming part of a GSM network for accessing the IM system (0014).

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Referring to claim 16, McDowell et al. further teaches wherein said GSM network has SMS capability and said prospective user is initially connected to an SMSC server to control and manage said SMS therebetween, and wherein said SMSC server is directly connected to said IM server via said computer network (Figure 1; 18,12,36,38,40).

8. Claim 8 are rejected under 35 USC 103(a) as being unpatentable over McDowell et al. and Dennis and further in view of Smith et al. (U.S. Patent No. 6,333,973).

Referring to claim 8, McDowell et al. and Dennis teach the limitations of claim 8, including sourcing client specific address but do not teach sending an e-mail address to the email address of a registered user on said IM server. Smith et al. teaches sending an e-mail address to the email address of a registered user on said IM server (Column 8, Lines 1-10). Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the art of McDowell et al. and Dennis with the teaching of Smith et al. of sending an e-mail address to the email address of a registered user on said IM server to integrate different types of messages from different types of equipment (Column 2, Lines 18-20).

9. Claims 18 and 20 are rejected under 35 USC 103(a) as being unpatentable over McDowell et al., Dennis and Patil and further in view of Smith et al. (U.S. Patent No. 6,333,973).

Referring to claims 18 and 20, McDowell et al., Patil and Dennis teach the limitations of claims 18 and 20, including sourcing client specific address but do not teach sending an e-mail

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address to the email address of a registered user on said IM server. Smith et al. teaches sending an e-mail address to the email address of a registered user on said IM server (Column 8, Lines 1-10). Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the art of McDowell et al., Patil and Dennis with the teaching of Smith et al. of sending an e-mail address to the email address of a registered user on said IM server to integrate different types of messages from different types of equipment (Column 2, Lines 18-20)

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ahuja et al. discloses method and system for notifying customers of transaction opportunities.

Chacker U.S. Patent No. 6,578,008 discloses method and system for an online talent business.

Dalal et al. U.S. Patent Publication No. 2002/0065894 discloses local presence state and user-controlled presence and message forwarding in unified instant messaging.

Fleming, III U.S. Patent No. 6,697,484 discloses method of programming telephone numbers and identifiers in a telephone.

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Foti U.S. Patent No. 5,577,9103 discloses method of providing service information to subscribers in a cellular telecommunications network using the short message service (SMS).

Gustafsson U.S. Patent No. 6,424,841 discloses short message service with improved utilization of available bandwidth.

Lorello et al. U.S. Patent No. 6,208,870 discloses short message service notification forwarded between multiple short message service centers.

Lohtia et al. U.S. Patent No. 2003/0211845 discloses system and method for providing subscriber-initiated information over a microbrowser.

Marwell et al. U.S. Patent No. 6,668,055 discloses personalized assistance system and method.

McCann et al. U.S. Patent Publication No. 2002/0037708 discloses access authentication system.

Mendiola et al. U.S. Patent Publication No. 2002/0007398 discloses instant messaging account system.

Pearl et al. U.S. Patent Publication No. 2002/0083035 discloses system and method for wireless delivery of text data.

Rennard et al. U.S. Patent No. 6,405,123 discloses method and system for an efficient operating environment in a real-time navigation system.

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Stephanson et al. U.S. Patent No. 6,108,325 discloses optimized SMS delivery algorithm.

Olsson et al. PCT/SE97/02081 discloses transporting short message service (SMS) messages within a telecommunications network.

Buhrmann et al. PCT/US97/08510 discloses personal information manager for updating a telecommunication subscriber profile.

Harris PCT/GB96/03135 discloses accessing telecommunications services

Tsoukas et al. PCT/AU97/00260 discloses telecommunications dissemination system

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James D Ewart whose telephone number is (703) 305-4826. The examiner can normally be reached on M-F 7am - 4pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bill Trost can be reached on (703)308-5318. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9306 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.

Ewart
March 21, 2004


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